UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,589	12/26/2001	Seiji Ohno	217577US0CONT	9443

22850 7590 01/26/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
FORD, JOHN M	

ART UNIT	PAPER NUMBER
1624	18

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
10/025579	Ohno et al
Examiner	**Group Art Unit**
T.M. Ford	1624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on July 31, 2003.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 42--61 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 42--52 is/are allowed.

☒ Claim(s) 53--61 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

Applicants' response of July 31, 2003, is noted.

The claims in the application are claims 42---61.

Claims 53 and 54 and 55 are rejected, as they are not written in proper composition form. A composition claim differentiates itself from a compound claim by including an inert carrier in a composition claim.

Claims 56---61 are rejected as a method claim needs an "effective amount of " clause.

There are too many uses here in claims 56—61 that takes one too far afield.

MPEP 806.05 (h) provides that restriction is proper, that is, restricting out the method claims altogether is proper where the compounds are presented for more than one use. The claims 56—61 become evidence claims to that allegation.

Claims 56—61 are indirect and vague, and do not meet the requirements of 35 USC 112, 1st paragraph.

Claims 56—61 should be re-written to a direct, singular, use.

Claims 42—52 are allowed.

A broad disclosure of utility as in the cited claims cannot be deemed in compliance with 35 U.S.C. 112, first paragraph.

The PTO has amended the guidelines to clarify "specific utility." The court focused on the fact that the applicant failed to identify a "specific utility" in Brenner v. Manson. The utility need be one in the real World of Commerce.

The recent utility guidelines set by US PTO require the claim to meet the requirements as stated in Brenner v. Manson, 148 USPQ 689, which requires that utility

be developed to a point where "specific benefits exist in currently available form." Similar is the "immediate benefit to the public" standard that Nelson v. Bowler, 206 USPQ 880 refers to. The standard set forth in the concurring opinion of In re Hartop, 135 USPQ 419 is "whether the invention has been brought to such perfection as to be capable of practical employment." This language is echoed in Bindra vs. Kelly, 206 USPQ 570. Laboratory Screen Tests are not acceptable. Broad essay tests are not acceptable.

The Supreme Court declined to express a view as to whether patentability can be based on a product shown to inhibit the growth of tumors in laboratory animals. Brenner, Comr. Pats. V. Manson, (U.S.C. 1966) 383 U.S. 519, 148 USPQ 689. The Court did state, however, that Congress did not intend that a patent be granted on a chemical compound, or a process for its production, whose sole "utility" consists of its potential role as an object of use-testing reasoning the patent system is related to the World of Commerce, rather than the realm of philosophy ibid., 148 USPQ at 696.

John M. Ford

JOHN M. FORD
PRIMARY EXAMINER

Group Art Unit 1624

J. M. Ford/tgd

January 20, 2004